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PD

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/356,229	12/19/94	NILSSON	K 06/87-50439

HM12/1118  
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EXAMINER  
NGUYEN, B

ART UNIT	PAPER NUMBER
1641	38

DATE MAILED: 11/18/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**08/356,229**

Applicant(s)  
**Nilsson et al**

Examiner  
**Bao-Thuy L. Nguyen**

Group Art Unit  
**1641**



☒ Responsive to communication(s) filed on 8/11/99, 8/13/99 & 8/18/99

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 0 month(s), or thirty days whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 22-49 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 22-49 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

*Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 22-40, 43, and 46-49, drawn to a biosensor comprising a spacer molecule bound to a carbohydrate derivative, classified in class 204, subclass 403.
  - II. Claims 41 and 42, drawn to a method of binding a carbohydrate derivative to a gold surface, classified in class 422, subclass 57.
  - III. Claim 44, drawn to a biosensor comprising a structure represented by carbohydrate derivative-R-X-biosensor surface, classified in class 463, subclass 518.
  - IV. Claim 45, drawn to a biosensor comprising a structure represented by carbohydrate derivative-R-X-protein-biosensor surface, classified in class 435, subclass 287.9.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together. The method of Invention II does not result in the biosensor of Invention I.
3. Inventions I and III are unrelated. The biosensor of Invention I is different from the biosensor of Invention III. These biosensors are not disclosed as being capable of use together.
4. Inventions I and IV are unrelated. The biosensor of Invention I is different from the biosensor of Invention IV. These biosensors are not disclosed as being capable of use together.
5. Inventions II and III are unrelated. The method of Invention II does not result in the biosensor of Invention III.
6. Inventions II and IV are unrelated. The method of Invention II does not result in the biosensor of Invention IV.

7. Inventions III and IV are unrelated. The biosensor of Invention III is different from the biosensor of Invention IV. These biosensors are not disclosed as being capable of use together.

8. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II, III and IV, restriction for examination purposes as indicated is proper.

9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. The restriction is also deemed to be appropriate even though claims similar to the instant claims were previously represented in the parent case, because the instant claims are presented as independent and distinct invention, i.e. claims 41, 42, 44 and 45 do not depend on claim 29 (similar to original claim 1), therefore, claims 41, 42, 44 and 45 as independent inventions, lacking the limitation of claim 29, have not been searched nor examined, and are deemed to be different from the invention of claims 29-40, 43 and 46-49.

10. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bao-Thuy Nguyen whose telephone number is (703) 308-4243. The examiner can usually be reached Monday through Wednesday, from 8:30 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027. The fax phone number for this Group is (703) 308-4242 or (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

BTN  
October 21, 1999

  
CHRISTOPHER L. CHIN  
PRIMARY EXAMINER  
GROUP 1800/1641